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10/814,820	03/31/2004	James Phillip Hollandsworth	030627/274121	5314

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ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER
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DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

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01/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/814,820

Applicant(s)

HOLLANDSWORTH ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,11,12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/29/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2007 has been entered.

### ***Election/Restrictions***

2. The claims are now directed the following inventions:
- I. Claims 6, 11, 12 and 14, drawn to a device with a specific blade attachment/adjustment configuration, classified in class 83, subclass 498.
  - II. Claim 13, drawn to a device with a specific cutter configuration, classified in class 83, subclass 678.
  - III. Claim 15, drawn to a device with a specific cutter cooperation configuration, classified in class 83, subclass 345.
3. Claim 1 link(s) inventions I-III. The restriction requirement of the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise

requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116;  
amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. The inventions are distinct, each from the other because of the following reasons:

Subcombinations Disclosed As Useable Together

5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of Group I has separate utility such as without the plurality of cutting blades of Group II. Conversely, the subcombination of Group II has separate utility such as without the specific blade attachment/adjustment configuration of Group I. See MPEP § 806.05(d).

6. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of Group I has separate utility such as without the specific overlap configuration of Group III. Conversely, the subcombination of Group III has separate utility such as without the specific blade attachment/adjustment configuration of Group I. See MPEP § 806.05(d).

7. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of Group II has separate utility such as without the specific overlap configuration of Group III. Conversely, the subcombination of Group III has separate utility such as without the plurality of cutter blades of Group II. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Newly submitted claims 13 and 15 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons described above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13 and 15 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Information Disclosure Statement***

10. The information disclosure statement filed on October 29, 2007 has been received and the references listed thereon have been considered.

***Drawings***

11. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the collar fixedly engaging the second rotatable shaft as now set forth in claim 1 (lines 6-7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

12. Claim 12 is objected to because of the following informalities:

In claim 12, line 4, the recitation "at least one of the first sleeve and the second sleeve" has already been set forth, and this it seems that --said-- should be inserted before "at".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1, 6 and 11, 12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for the collar fixedly engaging the second rotatable shaft as now set forth in claim 1 (lines 6-7). Rather, support is provided for a key 21 that extends between the collar 24 and the second rotatable shaft 20 as described on page 8, line 18.



***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

15. Claims 1, 6, 11, 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 18, the recitation "first sleeve" appears to be inaccurate and renders the claim vague and indefinite, and it seems that "first" should be changed to --second--.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 6, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton, pn 3,172,326.

Hamilton discloses a slitter device with every structural limitation of the claimed invention including:

a first rotatable shaft (e.g., the upper/lower occurrence of 12) extending axially through a first cutting blade (e.g., the upper/lower occurrence of 10);

a second rotatable shaft (e.g., the other occurrence of 12) disposed substantially parallel to the first rotatable shaft;

a second cutting blade (e.g., the other occurrence of 10) having the second rotatable shaft extending axially therethrough, the second cutting blade being axially movable relative to the second rotatable shaft;

a collar (e.g., 20a, 20b) having the second rotatable shaft extending axially therethrough, the collar of fixedly engaging the second rotatable shaft wherein the collar comprises a radially-outward threaded surface;

a first sleeve (e.g., 30 or 34) having the collar extending axially therethrough, the first sleeve disposed axially adjacent to a first side of the second cutting blade, the first sleeve comprising a first radially-inward threaded surface configured for operably engaging the radially outward threaded surface of the collar such that the first sleeve is axially adjustable relative to the collar; and

a second sleeve (e.g., the opposed other one of 34 or 30) having the collar extending axially therethrough, the second sleeve disposed axially adjacent to an opposing second side of the second cutting blade such that the first sleeve and the second sleeve cooperate to secure the second cutting blade therebetween, the second sleeve comprising a second radially-inward threaded surface configured for operably engaging the radially outward threaded surface of the collar such that the first (second?) sleeve is axially adjustable relative to the collar and such that the second cutting blade can be adjusted to maintain a cutting position adjacent to the first cutting blade and in a fixed spaced relation from the first cutting blade so as to compensate for blade wear;

[claim 6] wherein at least one of the first and second cutting blades is substantially circular in profile (e.g., see Figs. 2, 3);

[claim 11] wherein the second cutting blade is rotationally secured to at least one of the first sleeve and the second sleeve (e.g., the sleeves are mounted against their corresponding the blades 10, 10 such that the cutting blades are each rotationally secured to the corresponding first and second sleeves at least during rotation/operation of the corresponding shaft);

[claim 14] wherein the axial spacing between the first cutting blade and the second cutting blade is about 0.003 to about 0.005 inches (e.g., similar to the present invention, Hamilton is adjustable as such).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton, pn 3,172,326.

Hamilton discloses a slitter device with every structural limitation of the claimed invention but lacks:

[claim 12] at least one pin extending axially from at least one of the first sleeve and the second sleeve to engage a corresponding axially-extending aperture defined by the second cutting blade so as to rotationally secure the second cutting blade to at least one of the first sleeve and the second sleeve.

Herman discloses a slitter device that includes such a pin configuration and teaches that the engagement of the pins and recesses will serve to secure the adjacent components to the shaft with which such components are associated. Therefore, it would have been obvious to one having ordinary skill in the art to provide such pins and recesses on the slitter device of Hamilton to secure the sleeves to the shaft as taught by Herman.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**